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NO. 7780 P. 1

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/878,743
	Filing Date	June 11, 2001
	First Named Inventor	John Linville
	Art Unit	1732
	Examiner Name	Mary Lynn Theisen
Total Number of Pages in This Submission	Attorney Docket Number	HILB-624C2

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☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$330.00)

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Application Number 09/878,743
Filing Date June 11, 2001
First Named Inventor John Linville
Examiner Name Mary Lynn Theisen
Art Unit 1732
Attorney Docket No. HILB-62402

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2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims Extra Claims Fee from below Fee Paid
Independent Claims -20** = X
Multiple Dependent Claims +3** = X

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

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1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for <i>ex parte</i> reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
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1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
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1806 180	1806 180	Submission of Information Disclosure Stmt	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial Number: 09/878,743
Filed: June 11, 2001
Group Art Unit: 1732
Examiner: Mary Lynn F. Theisen
Applicant: John Linville, Donald R. Maier and Patrick M. Saaf
Title: CASKET LID AND METHOD OF MAKING SAME

Cincinnati, Ohio 45202

December 8, 2003

Mail Stop Appeal Brief - Patents
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BRIEF ON APPEAL

This is an appeal from the decision of the Examiner finally rejecting claims 21-23 and 35. A copy of these claims appears in the Appendix to this Brief.

Real Party In Interest

This application is assigned to Batesville Services, Inc.

Related Appeals And Interferences

There are no related appeals or interferences.

Status Of The Claims

This application originally contained claims 1-35. In a Response To Restriction Requirement filed July 1, 2002, claims 21-32 and 35 were elected for prosecution. In an Official Action dated October 7, 2002, claims 1-20, 33 and 34 were withdrawn, claims 29-31 were allowed, claims 21-23 and 35 were rejected and claims 24-28 were objected to. In a Response dated March 7, 2003, claims 24 and 26 were amended. In a final Official Action dated April 7, 2003, claims 24-32 were allowed and claims 21-23 and 35 were finally rejected.

Status Of Amendments

No amendments have been filed subsequent to the final rejection.

Summary Of The Invention

Referring to Fig. 4, a lid 20 produced by the method of the present invention is illustrated. The lid 20 includes a crown 22 and a pie 24 at one end of the crown 22. The crown 22 and pie 24 together comprise a cover 26 having a pair of opposed sides 28 and a pair of opposed ends 30. A header 32 is positioned at the end 30 of the cover 26 opposite from the pie 24. A side rim member 34 is positioned at each side 28 of the cover 26 and an end rim member 36 is positioned at the end 30 of the cover 26 corresponding to the pie 24. The crown, pie, rim members and header are molded as a one-piece, unitary structure. Preferably, the lid is molded from a settable material of wood chips and binder. Preferably, the crown, pie, rim members and header include a wood grain pattern formed therein.

In another aspect, a casket lid comprises a crown and a pie at one end of the crown, the crown and pie together comprising a cover having a pair of sides and a pair of ends. A side rim member is positioned at each of the pair of cover sides and an end rim member is positioned at one of the cover ends, the crown, pie and rim members being molded as a one-piece, unitary structure.

Issues

1. Did the Examiner err in rejecting claims 21-23 and 35 under 35 U.S.C. §103(a) as being unpatentable over Edwards U.S. Patent No. 1,507,957 in view of Elder U.S. Patent No. 4,730,370 and Nishibori U.S. Patent No. 4,610,900?

Grouping Of The Claims

Of the finally rejected claims, claims 21 and 35 are independent claims. Claims 22 and 23 depend directly on claim 21. It is Appellants' position that there are at least three separately patentable groups of claims. Group 1 consists of claim 21. Group 2 consists of claims 22 and 23. Group 3 consists of claim 35. Appellants submit that each of these groups of claims are separately patentable from each of the others of the groups of claims for reasons which will be developed below in the argument.

Argument

The Examiner Employed Improper Hindsight To Reject The Claims As Nothing Suggests The Combination Of References

Of the claims rejected, claims 21 and 35 are independent claims. Claim 21 calls for a casket lid. The casket lid comprises a crown, a pie at one end of the crown, the

crown and pie together comprising a cover having a pair of sides and a pair of ends, a header at one end of the cover opposite from the pie, a side rim member at each of the pair of cover sides and an end rim member at the other end of the cover, wherein the crown, pie, rim members and header are molded as a one-piece, unitary structure. Claim 35 is also for a casket lid. The claim calls for a crown, a pie at one end of the crown, the crown and pie together comprising a cover having a pair of sides and a pair of ends, a side rim member at each of the pair of cover sides and an end rim member at one of the cover ends, wherein the crown, pie and rim members are molded as a one-piece, unitary structure.

Both of these independent claims are directed to a molded, one-piece, unitary casket lid, not the lower body or shell portion of the casket as is disclosed in Edwards, nor a non-molded, non-one-piece, non-unitary casket lid as disclosed in Elder, and certainly not cellulose aggregate containing synthetic resin products molded into sheets, rods, boxes and the like to be used as a material for buildings such as floors, walls and ceilings, for furniture such as desks and cabinets and for the interior of automobiles as disclosed in Nishibori. Thus, assuming without admitting that the combination of the three references is even proper, which combination Appellants maintain is improper, the combination does not even yield the invention claimed in the claims under rejection.

More to the point however, the Examiner has failed to point to specific information in any of the references cited and applied that suggest their combination. Instead, the Examiner has merely described in detail the similarities between the references and the claimed invention, noting that one reference or the other—in combination with each

other--describes all the limitations of the pending claims. Nowhere did the Examiner particularly identify any suggestion, teaching or motivation to combine the references, nor did the Examiner make specific--or even inferential--findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. To the contrary, the Examiner's obviousness analysis is limited to a discussion of the ways that the prior art references can be combined to read on the claimed invention. Such a reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the references teach or suggest their combination to yield the claimed invention. For this reason the §103(a) obviousness rejections of the claims are improper as a matter of law and should be reversed.

The Federal Circuit has recently again strongly reaffirmed this cardinal principal of law. In In re Dembiczak, 50 USPQ 2d 1614, 1717-1618 (Fed. Cir. 1999), the Court stated:

All the obviousness rejections affirmed by the Board resulted from a combination of prior art references, e.g., the conventional trash or yard bags, and the Holiday and Shapiro publications teaching the construction of decorated paper bags. See *Dembiczak*, slip op. at 6-7. To justify this combination, the Board simply stated that "the Holiday and Shapiro references would have suggested the application of . . . facial indicia to the prior art plastic trash bags." *Id.* at 18-19. However, rather than pointing to specific information in Holiday or Shapiro that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other -- in combination with each other and the conventional trash bags -- described all of the limitations of the pending claims. See *id.* at

18-28. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific -- or even inferential -- findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. See, e.g., *Pro-Mold & Tool*, 75 F. 3d at 1573, 37 USPQ2d at 1630.

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. For example, the Board finds that the Holiday bag reference depicts a "premanufactured orange" bag material, see *Dembiczak*, slip op. at 21, finds that Shapiro teaches the use of paper bags in various sizes, including "large", see *id.* at 22-23, and concludes that the substitution of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an obvious design choice, see *id.* at 24. Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. See *Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1459 (noting Board's failure to explain, when analyzing the prior art, "what specific understanding or technical principle . . . would have suggested the combination"). Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. See *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232; *Rouffet*, 149 F.3d at 1359, 47 USPQ2d at 1459; *Fritch*, 972 F.2d at 1265, 23 USPQ2d at 1783; *Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600; *Ashland Oil*, 776 F.2d at 297, 227 USPQ at 667.

(emphasis added)

Even more recently, the Federal Circuit spoke yet again on this issue. In In Re Sang-Su Leg, 61 USPQ2d 1430 (Fed. Cir. 2002), the Court first set out the legal standard:

As applied to the determination of patentability vel non when the issue is obviousness, 'it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section.' In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ('the central question is whether there is reason to combine [the] references,' a question of fact drawing on the Graham factors).

'The factual inquiry whether to combine references must be thorough and searching.' Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ('a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'')(quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ('Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.');

In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of

making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ('teachings of references can be combined only if there is some suggestion or incentive to do so.') (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1265, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ('particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed'); In re Rouffet, 149 F.3d 1350, 1259, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ('even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.');

In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references').

The Court then went on to identify the reversible error made by the Examiner and the Board in their obviousness analyses:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that 'the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software' and that 'another motivation would be that the automatic demonstration mode is user

friendly and it functions as a tutorial' do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.' W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....

In its decision on Lee's patent application, the Board rejected the need for 'any specific hint or suggestion in a particular reference' to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action. (citations omitted)

The foundation of the principle of judicial deference to the rulings of the agency tribunals is that the tribunal has specialized knowledge and expertise, such that when reasoned findings are made, a reviewing court may confidently defer to the agency's application of its knowledge in its area of expertise. Reasoned findings are critical to the performance of agency functions and judicial reliance on agency competence. See Baltimore and Ohio R.R. Co. v. Aberdeen & Rockfish R.R. Co., 393 U.S. 87, 91-92 (1968) (absent reasoned findings based on substantial evidence effective review would become lost 'in the haze of so-called expertise'). The 'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. This court explained in Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697, that 'deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common

sense." The Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability. 'Common knowledge and common sense,' even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. See Allentown Mack, 522 U.S. at 376 ("Because reasoned decisionmaking demands it, and because the systemic consequences of any other approach are unacceptable, the Board must be required to apply in fact the clearly understood legal standards that it enunciates in principle')

....

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of 'the person having ordinary skill in the art to which said subject matter pertains,' the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

(emphasis added)

The same holds true here. The Examiner has not adequately supported the selection and combination of the references. The Examiner has simply made the conclusory

statement in the Official Action that "Edwards discloses a casket lid that is molded using cellulosic material (wood pulp, rice straw, paper pulp) in an appropriately shaped mold. Elder shows a casket lid having a crown, pie, rim and header. It would have been obvious to one of ordinary skill in the art to use the method of Edwards to form a casket with a pie, crown, rim and header because this is a conventional shape for caskets as evidenced by Elder." This simply does not adequately address the issue of motivation to combine. "Can be combined" is not the same as "is obvious to combine." This obviousness question is not resolved by the Examiner's subjective belief and unknown authority. Where in the record, Appellants rightfully ask, is the evidence of motivation to combine these references? There simply is none. Omission thereof is both legal error and arbitrary agency action. For this additional reason the §103(a) obviousness rejections of the claims are improper as a matter of law and should be reversed.

The Examiner Utilized Her Own Speculation And Unfounded Assumptions To Reject The Claims

The Examiner's obviousness rejection of the claims can, then, only be based on her own speculation. However, it is well settled that the Examiner is prohibited from substituting her own speculation and unfounded assumptions for the factual knowledge of a person skilled in the art. As was stated more than thirty years ago by the CCPA:

The Supreme Court in Graham [Graham v. John Deere Co., 383 U.S. 1] and Adams [U.S. v. Adams, 383 U.S. 39], supra, foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness must be supported by facts.

....

The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.

In Re Warner and Warner, 154 USPQ 173, 177-178 (CCPA 1967) (emphasis in original).

The CCPA's statement of the law is as valid today as it was then. For example, the Board itself has since stated:

As stated in In Re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA), the legal conclusion of obviousness must be supported by facts. Where the legal conclusion is not supported by facts it cannot stand.

Ex parte Saceman, 27 USPQ 2d 1472 (Bd. Pat. App. and Int. 1993) (emphasis added).

The Examiner maintains that: "Motivation doen [sic, does] not need to come from the references themselves but can come from the knowledge generally available to one of ordinary skill in the art. (citation omitted) Part of the Examiners [sic, Examiner's] function is to determine knowledge generally available to one of ordinary skill in the art. Elder and Edwards are both directed to caskets. Edwards and Nishibori disclose molding. One of ordinary skill in the art of molding caskets would be knowledgeable of both caskets and molding and would consider it obvious to combine features of the references." It is respectfully submitted that unless the Examiner relies on the references of record themselves to establish that their combination is "knowledge generally available to one of ordinary skill

in the art" she runs the risk, as she has done here, of substituting her own speculation and unfounded assumptions for that "knowledge generally available to one of ordinary skill in the art." Appellants do not dispute that the references, individually, are knowledge generally available to one of ordinary skill in the art to which the inventions of the references pertain; Appellants do however dispute that the combination of the references is knowledge generally available to one of ordinary skill in the art to which the claimed invention pertains. Here the Examiner merely speculates as to the propriety of the combination -- such is not the proper basis for an obviousness rejection.

Conclusion

For the foregoing reasons, it is submitted that the §103(a) rejections are in error. Reversal of the rejections is thus respectfully requested.

Respectfully submitted,

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APPENDIX

Claim 21. (Original) A casket lid comprising:

a crown;

a pie at one end of said crown, said crown and pie together comprising a cover having a pair of sides and a pair of ends;

a header at one of said ends of said cover opposite from said pie; and

a side rim member at each of said pair of cover sides and an end rim member at the other of said cover ends;

said crown, pie, rim members and header being molded as a one-piece, unitary structure.

22. (Original) The casket lid of claim 21 wherein said lid is molded from a settable material of wood chips and binder.

23. (Original) The casket lid of claim 21 wherein said crown, pie, rim members and header include a wood grain pattern formed therein.

35. (Original) A casket lid comprising:

a crown;

a pie at one end of said crown, said crown and pie together comprising a cover having a pair of sides and a pair of ends; and

a side rim member at each of said pair of cover sides and an end rim member at the other of said cover ends;

said crown, pie and rim members being molded as a one-piece, unitary structure.